

## REMARKS

Reconsideration of the above referenced application in view of the following remarks is requested. Claims 1, 13, 25, and 33 have been amended. Claims 36-38 have been cancelled. Claims 2, 4, 6, 14, 16, 18, 28, 31, and 34 were previously cancelled. New claims 39-42 have been added. Existing claims 1, 3, 5, 7-13, 15, 17, 19-27, 29-30, 32-33, 35 and newly added claims 39-42 remain active in the application.

## **ARGUMENT**

### ***Claim Rejections - 35 U.S.C. § 103***

Claims 1, 3, 5, 7-10, 12, 13, 15, 17, 19-22, 25-27, 29-30, 33, and 35-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Junqua et al. (US 6,324,512) (hereinafter Junqua) in view of Cohen et al. (EP 1 014 277) (hereinafter Cohen) further in view of Nosohara (EP 0 838 765) (hereinafter Nosohara).

Claim 1 has been amended to include “summarization” limitations. The Examiner erroneously asserted that Junqua (col. 3, lines 18-34) teaches or suggests a summarization element. Junqua describes an interactive electronic program guide system using spoken language. Users can speak their commands to the audio/video system directly or through the telephone or the Internet. If the system finds the requested program in a specific database (a copy of current electronic program guide, see Junqua col. 3, lines 18-31), the system formulates a response, informing the user that the program is, or is not, available. The formulation of the response in Junqua is simply a process of filling slots. For example, the system only needs to fill the slots in a

template response such as, (Slot 1: requested\_program) is (Slot 2: yes\_no) available on (Slot 3: requested\_day) (see Junqua col. 4, lines 12-51).

In marked contrast, the summarization limitation recited in amended claim 1 is performed by an automatic summarization module, which generates a short summary (gist) for the search results, if necessary. The search in the present invention is performed through multiple search engines over multiple databases. The user desired information may be scattered in many search results and some results may be very long. The automatic summarization module (36 in Fig. 1) may produce a shorter summary text from these search results. Also, there are some other situations where automatic summarization proves very useful. For example, if the user, who may have difficulty distinguishing certain colors, prefers to read the search results in a textual form when the results include a color figure, the automatic summarization module may produce a summary text for the color figure (see the specification, page 5, lines 17-26). The natural language generation module may further convert the summary text to a readable text with a prosodic pattern so that the readable text can be read to the user through the text to speech module in a natural and grammatically correct way. The natural language generation module converts the summary text into the natural language format. The text to speech module subsequently presents the converted summary text to the user in the synthesized speech format.

The summary text provided by the automatic summarization module in the present invention is not suggested by the response formulated by the dialog manager in Junqua though filling slots in a template, which simply advises the user "that the program is, or is not, available for viewing on the requested day." These two different

concepts are not related. Throughout the entire patent, Junqua teaches or suggests nothing about automatic summarization, as recited in amended claim 1.

The Examiner asserted that response formulation by filling slots in a template in Junqua is equivalent to automatic summarization, when rejecting original claims 36-38 (which recited the automatic summarization limitation). No support can be found throughout Junqua for this interpretation. In Junqua, a search is only conducted within in "a current copy of the electronic program guide" (col. 3, lines 18-31). An electronic program guide only contains entries such as program titles, showing time, and showing channel. The dialogue manager only needs to obtain the relevant entries based on a user's query and use what is contained in the entries to directly fill in slots in a response template (see Junqua col.4, lines 12-51 as well as the description of parser). Response formulation in Junqua does not involve automatic summarization to produce a short summary of search results which may be found in difference sources (databases) and may be in different formats, as recited in amended claim 1. Thus, no automatic summarization as recited in amended claim 1 is performed in Junqua.

Additionally, claim 1 is amended to include a "prosodic pattern" limitation to the second text generated by a natural language generation module. As clearly described in the specification (page 9, lines 17-27), the natural language generation module does not simply convert summarized search results into another plain text. The second text the natural language generation module produces includes a selected prosodic pattern, which makes the second text sound natural and grammatically correct when the second text is rendered by the text to speech module. Nowhere does Junqua, Cohen, or

Nosohara, alone or in combination, teach or suggest the “prosodic pattern” limitation, as recited in amended claim 1.

Because Junqua, Cohen, or Nosohara, alone or in combination, does not teach or suggest the automatic summarization and prosodic pattern limitations in amended claim 1, amended claim 1 is thus allowable. It is not necessary to discuss whether the cited references, alone or in combination, teaches or suggests other limitations recited in amended claim 1.

Amended independent claims 13, 25, and 33 enjoy features similar to those of amended claim 1 and are, likewise, allowable over the cited references for reasons analogous to those presented above with respect to amended claim 1.

Because independent claims 1, 13, 25, and 33 are allowable, all claims dependent therefrom are also allowable (e.g., existing claims 3, 5, 7-12, 15, 17, 19-24, 26-27, 29-30, 32, 35 and newly added claims 39-42).

Alternatively, the Examiner did not fulfill his duty to meet the requirements specified in MPEP § 706.02(j) when rejecting claims 1, 13, 25, and 33 under 35 U.S.C. § 103 based on a combination of Junqua, Cohen, and Nosohara. MPEP § 706.02(j) provides:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure (citation omitted).

Additionally, MPEP § 2143.01 provides:

The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (emphasis added, citation omitted).

In the Office Action dated December 22, 2003, the Examiner asserted that Cohen's teaching of language identification and Nosohara's teaching of translation can be combined with Junqua to teach or suggests all limitations in claim 1. However, the Examiner does not state a suggestion or motivation to combine the teachings in these three references.

Junqua describes an interactive electronic program guide system using spoken language. Users can speak their commands to the audio/video system directly or through the telephone or the Internet. If the system finds the requested program in a copy of current electronic program guide (see Junqua col. 3, lines 18-31), the system formulates a response, informing the user that the program is, or is not, available. Throughout Junqua, there is no showing of the desirability for combining a spoken language based interactive electronic program guide system with a language identification system. Even for a person of ordinary skill in the art, such a combination is not desirable because an electronic program guide system is mainly used at home. There is no such necessity to include spoken language identification into such a system because when a user purchases such a system, s/he knows what language is spoken in his/her home. Additionally, a motivation for combining translation technology with a spoken language based electronic program guide cannot be found from Junqua. Neither would a person of ordinary skill in the art desire to make such a combination because when an electronic program guide is used by a user, it only provides programs in a very limited number of languages (and probably only one language), and if there is

a need to translate between different languages for a particular program, the program provider would have done so.

The black letter law on this issue is pronounced by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 1369:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. ... *Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."* (citation omitted, emphasis added).

Here the Examiner simply did not follow this methodology. Because the Examiner did not prove any suggestion or motivation, either in cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Junqua, Cohen, and Nosohara, the 35 U.S.C. § 103 rejection of claim 1 must be withdrawn. Claim 1 is thus allowable.

Independent claims 13, 25, and 33 enjoy features similar to those of claim 1 and are, likewise, allowable over the cited references for reasons analogous to those presented above with respect to claim 1.

Because independent claims 1, 13, 25, and 33 are allowable, all claims dependent therefrom are also allowable (e.g., existing claims 3, 5, 7-12, 15, 17, 19-24, 26-27, 29-30, 32, 35 and newly added claims 39-42).

## CONCLUSION

Based on the foregoing, it is submitted that that all active claims 1, 3, 5, 7-13, 15, 17, 19-27, 29-30, 32-33, 35, 39-42 are presently in condition for allowance, and their

passage to issuance is respectfully solicited. If the Examiner has any questions, the Examiner is invited to contact the Steven P. Skabrat at (503) 264-8074. Entry of this amendment is respectfully requested.

Respectfully submitted,

Date: March 22, 2004

Paul A. Mendonsa  
Paul A. Mendonsa  
Registration No. 42,879

c/o Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1026

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on:

22 MARCH 2004  
Date of Deposit  
DEBORAH L. HIGGINS  
Name of Person Mailing Correspondence  
SOLLO —      3/22/04  
Signature                          Date